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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/995,931

11/28/2001

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04/28/2004

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EXAMINER

CHANNAVAJJALA, SRIRAMA T

ART UNIT

PAPER NUMBER

2177

DATE MAILED: 04/28/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/995,931

Applicant(s)

YU, PHILIP K.

Examiner

Srirama Channavajjala

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 November 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Drawings***

1. The drawings filed on 11/28/2001 are approved by the Draftsperson under 37 CFR 1.84 or 1.152.

### ***Information Disclosure Statement***

2. At page 04, line [017] applicant incorporated "BUSINESS 2.0 MAGAZINE AND RELATED MATERIAL", AND OTHER internet web-sites for example "www.savethis.com" Applicant is hereby required to submit these references in PTO-1449 in response to this office action, paper no. # 2.

### ***Priority***

3. Applicant's claim for domestic priority under 35 U.S.C. 119(e) is acknowledged based on Provisional Application Number 60/253,490 filed on November 28, 2000

### ***Claim Objections***

4. Claim 7-8, is objected to because of the following informalities: At page 15, Claim 7, line 2, Claim 8, line 5, database "though"a telecommunication network, should be database "through"a telecommunication network. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1- 7,10-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Drucker et al., [hereafter Drucker], US Patent No. 6292796.

6. As to Claim 1, 10, Drucker teaches a system which including 'method of using the Internet to retrieve and handle at least one printed article from a printed publication' [col 2, line 31-35,line 53-59, col 4, line 23-26, fig 6C], internet to retrieve and handle printed article from a printed publication corresponds to searching specific article or information from Internet Grateful Med or IGM as detailed in col 2, line 31-35, line 53-59;'providing at least one printed article that is to be published in print' [col 3, line 27-31, col 4, line 8-12 line 23-26, fig 6C]; 'assigning said at least one printed article with at least one tag' [col 4, line 32-44, col 8, line 37-52], printed article tags corresponds to series of URLs;; 'publishing said at least one printed article in print with its corresponding tag' [col 6, line 16-38, col 8, line 37-52, fig 6C]; 'storing said at least one

printed article in a database, said database being searchable based on said at least one tag' [col 6, line 65-67, col 7, line 1-6, col 9, line 1-8]; ' connecting said database to said Internet' [fig 8, fig 12, col 15, line 53-59] database corresponds to fig 8, element 518, Internet corresponds to fig 12, element 1225; 'receiving a request from an Internet client, said request including said at least one tag' [col 3, line 27-32, col 7, line 66-67, col 8, line 1-5]; 'searching through said database to locate said printed article matching said at least one tag' [col 8, line 18-26]; 'upon locating said printed article, sending said printed article to said Internet client' [col 8, line 20-22].

7. As to Claim 2, 11, Drucker teaches a system which including 'bundling additional information to said printed article when replying to said Internet client' [col 8, line 29-34].

8. As to Claim 3, Drucker teaches a system which including 'bundling additional information based on profile information supplied by said Internet client' [col 9, line 15-19].

9. As to Claim 4, Drucker teaches a system which including 'bundling based on the profile information supplied by Internet client and subject matter of said printed article' [col 9, line 37-51].

10. As to Claim 5, Drucker teaches a system which including 'prior to granting access to said database to said Internet client, pre-registering said Internet client for authentication [col 4, line 27-35, col 6, line 60-63], Drucker specifically teaches user ID, password that allows user to access to the information, and also allows users to setup for search criteria as detailed in col 4, line 27-35; 'upon authentication of said Internet client, processing said request from said Internet client' [col 4, line 30-35, col 6, line 63-67].

11. As to Claim 6, Drucker teaches a system which including 'sending said printed article comprises sending to an email address supplied by said Internet client' [col 6, line 39-41].

12. As to Claim 7, Drucker teaches a system which including 'connecting said database to a telecommunication gateway, said gateway being adapted to transmit a request from a Internet client to said database through a telecommunication network' [col 15, line 21-32, fig 8, fig 12], telecommunication network corresponds to communication interface coupling via network link connected to corresponding type of telephone line as detailed in col 15, line 21-30].

13. As to Claim 8, Drucker teaches a system which including 'upon pre-registering said Internet client, collecting and storing an email address of said Internet client for delivery' [col 8, line 55-62]; 'connecting said database to a telecommunication gateway,

said gateway being adapted to transmit a request from a Internet client to said database through a telecommunication network' [col 15, line 21-32, fig 8, fig 12], telecommunication network corresponds to communication interface coupling via network link connected to corresponding type of telephone line as detailed in col 15, line 21-30]; 'upon authenticating said Internet client, sending said printed article to said email address of said Internet client previously collected' [col 6, line 39-41, col 10, line 28-30].

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 9,12,15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drucker et al., [hereafter Drucker], US Patent No. 6292796 as applied to claim 1,10 above, and further in view of Loeb et al., [hereafter Loeb], US Patent No. 6014641.

15. As to Claim 9, Drucker teaches a system which including 'name of publication, author's anme, printed article's title' [see fig 2-3, fig 11, element 1104]. It is however, noted that Drucker does not specifically 'assigning a default code, said default code being published with said printed article when printed', although user can specifically query for example Journals such as NEJM or JAMA with publication date(s)

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[see col 11, line 25-30]. On the other hand Loeb disclosed 'assigning a default code, said default code being published with said printed article when printed' [fig 3, element 254 specifically teaches magazine ID; fig 4, table containing magazine ID, Magazine name, publisher ID data fields, also see fig 5-6, col 6, line 40-45, line 51-58].

It would have been obvious to one of the ordinary skill in the art at the time of applicant's invention to incorporate the teachings of Loeb et al., into improving access to literature of Drucker et al., because both are directed to searching databases, more specifically, Drucker is directed to accessing to literature such as medical, scientific current affairs, law, dental database libraries [see Abstract], while Loeb is directed to subscriptions to commodity items, more specifically open-ended subscription services to customers to various magazines that including access to publisher database, order and transaction [see Abstract].

One of the ordinary skill in the art at the time of applicant's invention would have been motivated to modify Drucker's reference to incorporate Loeb's fig 6 specifically magazine database, publisher's information or publisher ID and Magazine ID information because that would have allowed users of Drucker to control search query specific article(s) related to specific publisher or from a specific Magazine, thus improving the quality of subscription of various magazine subscriptions, wide selection of magazines can be provided under a continuous service program as suggested by Loeb [col 11, line 49-51].



16. As to Claim 12, Drucker teaches a system which including 'pre-registering each Internet Client by collecting and storing information regarding delivery means, profile' [fig 8,fig 11-12, col 8, line 35-41, line 58-62], Drucker specifically teaches Internet as detailed in fig 12, col 15, line 53-59, delivery means corresponds to either by e-mail message, facsimile and or like as detailed in col 8, line 58-62;'issuing to each Internet client an access code to said database' [fig 11, element 1202], Drucker specifically suggests userID>Password, setup info required to access database information [col 6, line 52-61], upon receiving a request from said Internet client, authenticating said Internet client' [col 6, line 56-61]. It is however, noted that Drucker does not specifically teach 'payment methods'. On the other hand, Loeb disclosed 'payment methods' [fig 6, see subscriber payment method as detailed in subscription record, col 8, line 17-21].

17. As to Claim 13, Drucker disclosed 'connecting said at least one database to a telecommunication gateway, said gateway being adapted to transmit a request with a tag from a telecommunication client to said database' [col 15, line 21-32,fig 8,fig 12]; 'upon authenticating said request from said telecommunication client, processing said request' [col 4, line 29-31, col 6, line 60-61]; 'upon locating an printed article matching said tag, transmitting said printed article to said telecommunication client based on specified delivery means' [col 6, line 39-41, col 10, line 28-30].

18. As to Claim 14, Drucker disclosed 'request is transmitted through a telephone connection to said database and said reply is transmitted to said client's preregistered email address' [col 6, line 39-41, col 8, line 35-46, line 53-62, col 15, line 24-32].

19. As to Claim 15, Drucker teaches a system which including 'method of using the Internet to retrieve and handle a plurality of printed article from a plurality of printed publication for at least one entity customer, said entity customer providing a plurality of Internet clients through said entity customer' [col 2, line 31-35, line 53-59, col 4, line 23-26, fig 6C], internet to retrieve and handle printed article from a plurality of printed publication corresponds to searching specific article or information from Internet Grateful Med or IGM as detailed in col 2, line 31-35, line 53-59, customer corresponds to user;' providing at least one printed article that is to be published in print' [col 3, line 27-31, col 4, line 8-12 line 23-26, fig 6C]; 'assigning said at least one printed article with at least one tag' [col 4, line 32-44, col 8, line 37-52], printed article tags corresponds to series of URLs; 'publishing each of said plurality of printed articles in print with its corresponding tag' [col 6, line 16-38, col 8, line 37-52, fig 6C]; 'storing said plurality of printed articles in at least one database, said at least one database being searchable based on said at least one tag' [col 6, line 65-67, col 7, line 1-6, col 9, line 1-8]; 'connecting said database to said Internet' [fig 8, fig 12, col 15, line 53-59], database corresponds to fig 8, element 518, Internet corresponds to fig 12, element 1225;'registering said entity customer by storing information, access rights criteria' [col 6, line 56-63col 13, line 13-19]; 'receiving a request from an Internet client, said

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request including said at least one tag' [col 3, line 27-32, col 7, line 66-67, col 8, line 1-5]; 'authenticating said Internet client to determine if said Internet client is allowed by said entity customer' [col 6, line 60-62, col 13, line 13-17]'searching through said at least one database to locate said printed article matching said at least one tag' [col 8, line 18-26]; 'upon locating said printed article, sending said printed article to said Internet client based on delivery method provided by said Internet client' [col 8, line 20-22, line 37-41, line 58-59]. It is however, noted that Drucker does not specifically teach payment methodology'. On the other hand, Loeb disclosed '[fig 6, see subscriber payment method as detailed in subscription record, col 8, line 17-21].

It would have been obvious to one of the ordinary skill in the art at the time of applicant's invention to incorporate the teachings of Loeb et al., into improving access to literature of Drucker et al., because both are directed to searching databases, more specifically, Drucker is directed to accessing to literature such as medical, scientific current affairs, law, dental database libraries [see Abstract], while Loeb is directed to subscriptions to commodity items, more specifically open-ended subscription services to customers to various magazines that including access to publisher database, order and transaction [see Abstract].

One of the ordinary skill in the art at the time of applicant's invention would have been motivated to modify Drucker's reference to incorporate Loeb's fig 6 specifically subscriber payment method and related customer or subscriber information as detailed

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in publisher #1 subscription record because that would have allowed users of Drucker not only control search query specific article(s) related to specific publisher or from a specific Magazine, but also tracks customer payment criteria, thus improving the quality of subscription of various magazine subscriptions, wide selection of magazines can be provided under a continuous service program as suggested by Loeb [col 11, line 49-51].

20. As to Claim 16, Drucker disclosed 'access rights criteria comprises granting rights to those Internet clients matching predetermined criteria identified by said entity customer' [col 4, line 27-35, col 6, line 60-63], on the other hand, Loeb disclosed 'payment methodology comprises user fee based' [col 8, line 17-21, line 42-45].

As to Claim 17, Drucker disclosed ' delivery method comprises only delivering said printed article to said entity customer's designated mailbox' [col 6, line 39-41, col 8, line 35-46, line 53-62].

21. Claims 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drucker et al., [hereafter Drucker], US Patent No. 6292796, Loeb et al., [hereafter Loeb], US Patent No. 6014641 as applied to claim 15 above, and further in view of Walker et al., [hereafter Walker], US Patent No. 6449616.

22. As to Claim 18, both Drucker and Loeb do not specifically teach 'commercial advertisement supplied by an advertiser, collecting a fee from said advertiser', although Loeb suggests subscribe published magazine, and subscriber payment method as detailed in fig 6. On the other hand, Walker disclosed "commercial advertisement supplied by an advertiser, collecting a fee from said advertiser" [col 4, line 8-16].

It would have been obvious to one of the ordinary skill in the art at the time of applicant's invention to incorporate the teachings of Walker et al. into improving access to literature of Drucker et al., open ended subscriptions to commodity items normally available only through term based subscriptions of Loeb et al., because they are all directed to searching electronic databases, more specifically, Drucker is directed to accessing to literature such as medical, scientific current affairs, law, dental database libraries [see Abstract], while Loeb is directed to subscriptions to commodity items, more specifically open-ended subscription services to customers to various magazines that including access to publisher database, order and transaction [see Abstract], Walker is directed to distributing supplemental information related to printed articles,

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more specifically electronic databases containing the supplemental information or third party intermediates handling requests for supplemental information [see abstract].

One of the ordinary skill in the art at the time of applicant's invention would have been motivated to combine the references because that would have allowed users of Drucker, Loeb to allow publishers to have related supplemental information included in the respective printed articles because users may benefit further interesting events /topics or articles or books related to the published articles thus improving the quality of advertisement related to printed articles, also generate revenue for customers and the publishers [col 2, line 59-67].

***Conclusion***

**The prior art made of record**

- a. US Patent No. 6292796
- b. US Patent No 6014641
- c. US Patent No. 6449616

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure

- d. US Patent No. 6704739
- e. US Patent No. 6549956
- f. US Patent No. 6546406
- g. US Patent No. 6148331
- h. US Patent No. 6389541
- i. US Patent No 6253188
- j. US Patent No 2001/0047362
- k. US Patent No 2002/0049781
- l. EP0775962A2
- m. EP1160693
- n. EP1158424A1
- o. GB2368423
- p. GB2328300

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Srirama Channavajjala whose telephone number is (703) 308-8538. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:30 PM Eastern Time. The TC2100's Customer Service number is (703) 306-5631.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene, can be reached on (703) 305-9790. The fax phone numbers for the organization where the application or proceeding is assigned are as follows:

703/746-7238	<b>(After Final Communication)</b>
703/872-9306	<b>(Offical Communications)</b>
703/746-7240	<b>(For Status inquiries, draft communication)</b>

Any inquiry of general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.

sc *q/*  
Patent Examiner.  
April 26, 2004.